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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,949	01/26/2004	Ming-Gung Li	14215 B	9325
23595	7590	07/26/2006	EXAMINER	
NIKOLAI & MERSEREAU, P.A. 900 SECOND AVENUE SOUTH SUITE 820 MINNEAPOLIS, MN 55402				GRAYSAY, TAMARA L
		ART UNIT		PAPER NUMBER
		3636		

DATE MAILED: 07/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/764,949	LI, MING-GUNG	
	Examiner Tamara L. Graysay	Art Unit 3636	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 27 April 2006.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1 and 2 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 27 April 2006 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

DETAILED ACTION

Drawings

1. The drawings were received on 27 April 2006. These drawings are accepted.

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

The specification does not provide antecedent basis for the claim limitation added at lines 9-10 of claim 1.

Claim Rejections - 35 USC § 112

3. Claims 1 and 2 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The limitation added at lines 9-10 of claim 1 is not supported by the original disclosure.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Huang (US-6655398) in view of Wang (US-2003/0221714).

Claim 1: Huang FIG. 4 depicts the claimed invention including the connections of each element of the umbrella frame comprising: a lower runner 12, a main shaft 10, an upper runner 11, a plurality of stretching frames 30. Each stretching frame 30 having a stretcher 33, a connection plate 35, an elastic rod 77, a connector 46, a distal rod 43, a long rib 40, and a short rib 31. The elements are connected as depicted at the left side of FIG. 4 of the present application. The hooks of the elastic rod are shown in Huang FIG. 2.

Huang lacks the stretcher being arcuate between the lower connection and the downward lobe and extending toward the upper connection.

Wang in FIG. 3 clearly depicts a stretcher 50 connected at a lower connection 30. The stretcher 50 is depicted in FIG. 3 as arcuate between the lower connection and the downward lobe (unnumbered) and extending toward the upper connection. Such an arrangement inherently provides greater volume beneath the umbrella frame for accommodating a person standing under the frame.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the stretcher of Huang to be arcuate, such as suggested by the arcuate stretcher of Wang, in order to provide greater volume beneath the umbrella frame for accommodating a person standing under the frame.

Further, a change in shape is generally recognized as being within the level of ordinary skill and not a patentable distinction over an otherwise unpatentable device.

See MPEP § 2144.04(IV)(B), which reads: *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) (The court held that the configuration of the claimed disposable plastic nursing container was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed container was significant.).

To that end, applicant has failed to argue any significance or unexpected result from the arcuate shape and has provided no evidence of any unexpected result from the arcuate shape. Instead, applicant has provided arguments (direction of forces and volume beneath the frame) in support of the arcuate shape each of which would have been recognized by one of ordinary skill in the umbrella art at the time the invention was made.

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Huang (US-6655398) and Wang (US-2003/0221714) as applied to claim 1, and further in view of Lin (US-6296001).

Claim 2: Huang, as modified by Wang, discloses the use of plastic having metal reinforcing (2:65-67) for the long rib (strut 31) but is silent as to the material used for the other elements.

Lin teaches an elastic rod 26 made of metal.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Huang and Wang combination to include various materials including metal for the elastic rod and plastic or plastic composition for the remaining structural elements because the particular material used for an element would have been a matter of design choice held to be within the level of ordinary skill in the art.

The design choice made by one of ordinary skill in the art would have taken into consideration the particular application and use of the element as well as the desired structural integrity of the element, not to mention cost. Applicant has not provided any unexpected result of using metal for the long rib, but rather has only stated the obvious – that generally, metal would be preferred in order to prolong the life of an element under repeated stress.

Therefore, the otherwise unpatentable device is not rendered patentable based on a design choice from among known materials.

Response to Arguments

6. Applicant's arguments with respect to claims 1 and 2 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamara L. Graysay whose telephone number is 571-272-6728. The examiner can normally be reached on Mon - Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Cuomo, can be reached on 571-272-6856. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Tamara L. Graysay
Examiner
Art Unit 3636